

REMARKS

Upon entry of this amendment, amended issued claim 1, original issued claims 2-11, and reissue claims 71-74, 76, 87, 115, 116, 118, and 122-146 will be pending in this application. By this amendment, original issued claim 1 is amended, reissue claims 48-54, 56-61, 75, 77-83, 85-98, 101-114, 117, and 119-121 are cancelled without disclaimer or prejudice, and claims 122-146 are added. No new matter has been added. Applicant requests the re-examination and the prompt allowance of this application.

Applicant includes Appendix A to this Reply indicating exemplary support for the new claims added herein. Applicant also includes Appendix B to this Reply indicating the amendments made to claim 1 relative to the previously pending version of claim 1.

Additionally, Applicant has filed a divisional reissue application of U.S. Patent 6,286,615, on which this reissue application is also based. Pursuant to M.P.E.P. § 1451, Applicant has amended the specification to insert the required notice of the multiple reissue applications.

Allowable Subject Matter

Applicant appreciates the indication of allowability of claims 1-11 and 71-76, 87, 116, and 118 if an acceptable supplemental declaration was submitted.¹ See Office Action at pg. 4, ¶ 8. As set forth below, Applicant submits herewith a Revised Reissue Declaration.

¹ Claim 115 was not specifically indicated as allowable in the Office Action. Claim 115, however, depends from claim 1, which was indicated as being allowable. Accordingly, Applicant believes that claim 115 is also allowable and was merely omitted from the listing of allowable claims provided in the Office Action.

Interview Summary

Applicant would like to thank Examiner Hurley for the courtesy of the personal interview conducted on May 13, 2008 with Roland McAndrews and John Cheek. During the interview, the parties generally discussed the pending rejection under 35 U.S.C. § 251 based on improper recapture and Applicant's proposal to submit claims directed to an "overlooked" aspect pursuant to M.P.E.P. § 1412.02. The new claims added and remarks made herein are consistent with the discussion made during the interview.

Reissue Oath/Declaration

In the Office Action mailed February 10, 200 ("the Office Action "), claims 1-11, 48-54, 56-61², 71-83, 85-98, and 101-121 were rejected under 35 U.S.C. § 251 as being based upon a defective reissue declaration. Claims 48-54, 55-61, 75, 77-83, 85-98, 101-114, 117, and 119-121 are cancelled herein rendering the rejection of these claims under 35 U.S.C. § 251 moot.

The Office Action stated that the reissue declaration filed on September 17, 2008 was defective because the error referenced therein and relied upon to support the reissue application was a limitation argued for patentability with respect to pending claims 12-14 during the original prosecution.³ Office Action at pg. 3, ¶ 6. The Office Action further stated that such an error is not an error upon which a reissue can be based. *Id.*

² Although claim 55 was listed in the claims rejected as being based on a defective declaration, see Office Action at pg. 4, ¶ 7, claim 55 was previously cancelled and thus not pending at the time of the Office Action.

³ Pending claims 12-14 of the original prosecution were renumbered as issued patent claims 9-11.

Applicant files herewith a Revised Reissue Declaration including an error to support the reissue application. The listed error does not reference a limitation argued for patentability with respect to original patent claims. Instead, the listed error references that the original patent claims need not include "rear steering means" as recited in, for example, issued claim 9. The rear steering means was not a claim recitation argued for patentability during original prosecution. Applicant submits that the Revised Reissue Declaration is in compliance with 37 C.F.R. § 1.175. Applicant requests that the Revised Reissue Declaration be accepted and the rejection under 35 U.S.C. § 251 based on a defective oath be withdrawn. Accordingly, Applicant submits that claims 1-11, 71-74, 77, 87, 115, 116, and 118 are allowable. The allowability of these claims upon submission of an acceptable declaration was confirmed by the examiner in the Office Action. See Office Action at pg. 4, ¶ 8.

Recapture Rejections

In the Office Action, claims 48-54, 56-61, 77-83, 85-86, 88-98, 101-115, 117, and 119-121 were rejected under 35 U.S.C. § 251 as being improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. Office Action at pgs. 2-4, ¶¶ 2-5. Applicant has cancelled these claims herein rendering the rejection thereof moot. Accordingly, Applicant requests that the rejection under 35 U.S.C. § 251, based on improper recapture, be withdrawn.

New Claims

Applicant has added new claims 122-146 and submits that each of these claims is allowable for at least the following reasons.

A reissue application will not be granted to recapture claimed subject matter that was surrendered in the application for the original patent. *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335 (Fed. Cir. 2005). As set forth by the Federal Circuit, the recapture rule is applied as a three-part test. *Id.* First, the reissue claims are analyzed to determine whether and in what aspects they are broader in scope than the original patent claims. *Id.* Second, the broader aspects of the reissue claims are analyzed to determine whether they relate to subject matter that was surrendered during prosecution of the original patent. *Id.* Surrendered subject matter can occur by arguments or claim changes made during prosecution of the original patent.⁴ *Hester Industries Inc., v. Stein, Inc.*, 142 F.3d 1472 (Fed. Cir. 1998). Third, the reissue claims are analyzed to determine whether they are materially narrowed in other respects, such that they have not been enlarged and thus avoid the recapture rule. *North American Container, Inc.*, 415 F.3d 1335. Reissue claims are materially narrowed in other respects when they include “overlooked aspects” of the invention. *Hester Industries*, 142 F.3d 1472. Overlooked aspects are claim limitations that were not included in the claims of the original patent. *Id.*

The Patent Office’s position on the current state of the law on reissue recapture was included in an Appendix to the Office Action. See Office Action at pgs. 6-9. Consistent with the Federal Circuit case law discussed above, and in particular the third step of the recapture analysis, the Appendix to the Office Action states that recapture is avoided if the reissue claim is materially narrowed. *Id.* The summary further stated that

⁴ In addition reissue claims cannot be (i) the same scope as or (ii) broader in scope than the claims that were cancelled from the original patent application. *Ball Corp. v. United States*, F.2d at 1436; M.P.E.P. §§ 1412.02(I)(C)(1)(a) and 1412.02(VI).

a reissue claim is materially narrowed when it includes aspects of the invention (i) “which had not been claimed and thus were overlooked during prosecution of the original patent application” and (ii) “which patentably distinguish over the prior art.” *Id.*

M.P.E.P. § 1412.02 mirrors the Federal Circuit’s three step test for recapture. In particular, M.P.E.P. §§ 1412.02(I)(C) and 1412.02(V) explain and set forth several examples of determining whether reissue claims are materially narrowed in other respects so as to avoid the recapture rule -- the third step of the recapture test. For example, M.P.E.P. § 1412(I)(C) states that if “the reissue claim(s) are really claiming additional inventions/embodiments/species not originally claimed (i.e., overlooked aspects of the disclosed invention), then recapture will not be present.” Additionally, M.P.E.P. § 1412.02(V) provides examples of where surrendered subject matter may be broadened or excluded from a reissue claim, yet recapture is avoided because the reissue claim also includes an overlooked aspect.

Thus, regardless of whether reissue claims are broader with respect to surrendered subject matter, recapture is avoided if the reissue claims recite an overlooked aspect of the invention.

Applicant respectfully submits that new independent claims 122-146 satisfy the third step of the recapture rule and, thus, avoid recapture because at least each of independent claims 122, 130, 138, and 146 include an overlooked aspect. For example, independent claim 122 recites “a steering system ... configured to simultaneously steer (i) both of the first and second front supports and (ii) only the first rear support;” independent claim 130 recites “a steering system ... configured to simultaneously steer (i) both of the first and second front tracks and (ii) only the first rear

track;” independent claim 138 recites “a steering system ... configured to simultaneously steer (i) both of the first and second front supports and (ii) only the first rear support;” and independent claim 146 recites “wherein said at least one rear wheel or track is the only one of said rear wheels or tracks that is steered about a vertical steering axis.” (Emphasis added.) This aspect that only one of the rear supports is steerable is an overlooked aspect of the invention, in that this aspect is not included in any of the claims of the original patent, and was not included in any claim during the prosecution of the original patent. Each of the claims of the original patent require both of the rear supports to be steerable or maneuverable. For example, original patent claim 1 recites “at least one pair of rollable rear supports ... [and] a maneuvering system ... for rotating said rear supports ... while turning the front supports,” and original patent claim 9 recites “at least one pair of rollable rear supports ... [and] rear steering means ... for steering said rear supports.” (Emphasis added.)

Accordingly, for at least the reasons set forth above, Applicant submits that each of new independent claims 122, 130, 138, and 146, as well as new dependent claims 123-129, 131-137, and 139-145, include an overlooked aspect, satisfy the third step of the recapture test, and thus avoid recapture. In addition, Applicant submits that the prior art of record fails to disclose or suggest, for example, among other things, this overlooked aspect of the new claims.

Conclusion

In view of the above, Applicant respectfully submits that pending claims 1-11, 71-74, 76, 87, 115, 116, 118, and 122-146 are in condition for allowance. Accordingly,

Applicant respectfully requests reconsideration and reexamination of this reissue application and timely allowance of the pending claims.

The Office Action contains characterizations of the claims with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization of the Office Action.


If the Examiner believes a telephone conversation might advance prosecution, the Examiner is invited to call Applicant's undersigned representative at 202-408-4397.

Please grant any additional extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
Timothy P. McAnulty
Reg. No. 56,939